

REMARKS

The Office Action has been carefully reviewed. Claims 1-31 are pending. Claims 1, 8, 14 and 31 have been amended. No new matter has been added. Entry of the amendments to the claims is respectfully requested. Reconsideration of the outstanding objections/rejections in the present application is also respectfully requested based on the following remarks.¹

I. Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-31 have been rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to point out and distinctly claim the subject matter which Applicant regards as the invention. *See* Office Action, pages 2-3. Applicant hereby respectfully traverses this rejection.

Regarding claims 1, 14, and 31, the Examiner asserts that the recitation “a customer of a financial institution or an entity associated with the financial institution” is unclear. Applicant respectfully disagrees. However, in order to forward the present application toward allowance, Applicant has amended claims 1, 14, and 31 to clarify the inventions claimed in each. Claim 1 as amended recites “a receiving unit configured to receive information associated with a consumer who is a customer of **at least one of** a financial institution **and** an entity associated with the financial institution.” Applicant notes that MPEP 2173.05(h) states “[a]lternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims.” Applicant submits that as worded claim 1 states that a

¹ As Applicant’s remarks with respect to the Examiner’s rejections are sufficient to overcome these rejections, Applicant’s silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes, Examiner interpretations of claims, Examiner interpretations of the specification) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

receiving unit is configured to receive information associated with a consumer who is a customer of a financial institution, an entity associated with the financial institution, or a customer of both. Applicant submits that claim 1 as amended presents no uncertainty or ambiguity with respect to the question of scope or clarity of the claim.

Regarding claims 14 and 31, although these claims are of different scope than claim 1, they are allowable for analogous reasons. For example, claim 14 recites “receiving information related to personal identification information associated with a consumer who is a customer of **at least one of** a financial institution **and** an entity associated with the financial institution, the consumer personal identification information being transmitted prior to a consumer contact.” Claim 31 contains a similar recitation.

The Examiner has additionally rejected claims 14 and 31 as allegedly being indefinite for reciting a conditional step of “offering..., if confirmation is received.” *See* Office Action, page 3. Specifically, the Examiner asserts the claims are unclear because they “do not have the step(s) of what to do next if the confirmation is not received or if the confirmation is received but the consumer is NOT pre-qualified.” *See Id.* Applicant respectfully disagrees with the assertion that because the claims do not cover all potential conditions they are indefinite. Applicant is unaware of any regulation or rule requiring potential outcomes of a method to be explicitly recited. Claim 14 recites “offering the consumer the financial instrument for which he or she is pre-qualified, if the received pre-qualification data from the third party indicates that the consumer is pre-qualified for a financial instrument.” Applicant submits that the use of a condition or a supposition, such as “if” does not make a claim indefinite. On the contrary, the claim states a condition which if met will achieve a particular result.

Additionally, Applicant notes that claims 14 and 31 use the transitional phrase “comprising” which does not exclude other steps from being included in a system. *See* MPEP 2111.03 “The transitional term ‘comprising’, which is synonymous with ‘including,’ ‘containing,’ or ‘characterized by,’ is inclusive or open-ended and does not exclude additional, unrecited elements or method steps.” Thus the invention of claims 14 and 31 could include additional steps. However, as stated above, Applicant is unaware of any rule or requirement that the claims must include steps for all potential conditions.

As stated in MPEP § 2173.04, breadth of a claim is not to be equated with indefiniteness. In re Miller, 441 F.2d 689 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if Applicant has not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

Claims 2-13 and 15-30 are rejected for their dependency upon independent claims 1 and 14, respectively. Thus, since independent claims 1 and 14 should be allowable as discussed above, claims 2-13 and 15-30 should also be allowable at least by virtue of their dependency on independent claims 1 and 14, respectively.

In view of the foregoing, Applicant respectfully requests that the aforementioned indefiniteness rejection of claims 1-31 be withdrawn.

II. Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 14-31 have been rejected under 35 U.S.C. § 112, first paragraph as allegedly as containing subject matter which was not described in the specification in such a way as to enable

one skilled in the art to make and/or use the invention. *See* Office Action, pages 3-4. Applicant hereby respectfully traverses this rejection.

The Examiner asserts that claims 14 and 31 “are inadequate because the critical step of ‘consumer contacts system’ (see Applicant’s Specification, Figure 3/element 315) is not disclosed in the claims.” *See* Office Action, page 4. Applicant responds that MPEP 2164.08(c) states “an enablement rejection based on the grounds that a critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended.” Applicant submits that the “consumer contacting the system” is not a critical element of claim 14 or of claim 31.

Accordingly, Applicant respectfully requests the withdrawal of the enablement rejection of claims 14-31.

III. Rejections Under 35 U.S.C. § 103

Claims 14-31 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,055,573 to Gardenswartz *et al.* (“Gardenswartz”) in view of U.S. Patent No. 7,310,617 to Cunningham (“Cunningham”). *See* Office Action, pages 4-9. Applicant hereby respectfully traverses this rejection.

A. Gardenswartz and Cunningham Fail to Teach or Suggest All of the Elements of Claims 14-31

Claim 14 of the present application recites:

receiving pre-qualification data from the third party
wherein the pre-qualification data relates to a determination of
whether a consumer identifier associated with the consumer is
contained in a suppression database, wherein the suppression
database comprises a plurality of second consumer files, each of

the second consumer files linked to a unique consumer identifier, wherein the second consumer files comprise suppression information relating to a determination that the consumer associated with the second consumer file is no longer qualified to be offered one or more of the pre-qualified financial instruments stored in the first consumer file

Applicant respectfully submits that Gardenswartz and Cunningham, either singly or in combination, fail to teach or suggest “receiving pre-qualification data from the third party wherein the pre-qualification data relates to a determination of whether a consumer identifier associated with the consumer is contained in a suppression database,” as recited by claim 14.

Regarding claim 31, although this claim is of different scope than claim 14, this claim is allowable over Gardenswartz and Cunningham for analogous reasons. For example, claim 31 recites “receiving pre-qualification data from the third party wherein the pre-qualification data relates to a determination of whether a consumer identifier associated with the consumer is contained in a suppression database.” Gardenswartz and Cunningham, either singly or in combination, fail to teach or suggest “receiving pre-qualification data from the third party wherein the pre-qualification data relates to a determination of whether a consumer identifier associated with the consumer is contained in a suppression database.”

Regarding claims 15-30, these claims are dependent upon independent claim 14. Thus, since independent claim 14 should be allowable as discussed above, claims 15-30 should also be allowable at least by virtue of their dependency on independent claim 14. Moreover, these claims recite additional features which are not taught or even suggested, by the applied references taken either alone or in combination.

As stated in MPEP § 2143.03, to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). That is, “[a]ll words in a claim must be considered in judging the

patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382 (CCPA 1970).

B. Modifying Gardenswartz to Offer a Product Based on Pre-Qualification Would Render Gardenswartz Unsatisfactory For Its Intended Purpose

Claim 14 of the present application recites “**offering the consumer the financial instrument** for which he or she is pre-qualified, **if confirmation is received from the third party that the consumer is pre-qualified for a financial instrument.**” The Office admits that Gardenswartz “does not expressly teach pre-qualifying a consumer for a ‘financial instrument.’” *See* Office Action, page 6. The Office asserts that a person of ordinary skill in the art would have been motivated to modify Gardenswartz to “include the features of financial card offering as taught by Cunningham.” *See* Office Action, page 6. Applicant respectfully disagrees.

Gardenswartz states “one object of this invention is to provide a novel method, system, and computer program product for delivering targeted advertisements to a consumer based on his or her offline purchase history.” *See* Gardenswartz, column 2, lines 58-61. Applicant notes that other listed objects of invention are similarly associated with a consumer’s offline purchase history. *See* Gardenswartz, column 2, lines 62 - column 3, line 4. *See also* Figures 5, 6, 8, 9, and 11. Gardenswartz’s offering of targeted advertisements is based upon offline purchase history, not “if confirmation is received from the third party that the consumer is pre-qualified for a financial instrument,” as recited by claim 14. In fact, Gardenswartz is directed towards “Communicating With a Computer Based On An Updated Purchase Behavior Classification of a Particular Consumer.” *See* Gardenswartz Title. Modifying Gardenswartz as proposed by the Office would require Gardenswartz to offer a consumer a financial instrument “if confirmation is received from the third party that the consumer is pre-qualified for a financial instrument,” not based upon the consumer’s offline purchase history. Applicant respectfully submits that

modifying Gardenswartz as proposed by the Office, would render Gardenswartz unsatisfactory for its intended purpose.

As stated in MPEP § 2143.01, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 (Fed. Cir. 1984). Further, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810 (CCPA 1959).

Furthermore, Gardenswartz teaches away from making the proposed modifications. To modify Gardenswartz as proposed would require Gardenswartz to inquire of a third party “based on the received information related to personal identification information.” Gardenswartz states “[i]t is another object of the present invention to provide a novel method, system, and computer program product for providing advertisers with information relating to consumers' observed offline purchase histories **without divulging to the advertisers the proprietary information of another, such as the consumers' customer identifications (CIDs).**” *See* Gardenswartz, column 2, line 66 - column 3, line 4 (emphasis added). Gardenswartz states in numerous places that it is undesirable to disclose customer identifications to third parties. *See* Gardenswartz, column 2, line 66 - column 3, line 4; and Gardenswartz column 13, lines 40-45. Thus, Gardenswartz teaches away from a proposed modification which would require disclosure of personal identification to third parties. For at least these reasons the Office’s proposed modifications are improper.

C. **Gardenswartz Fails to Teach or Suggest the Consumer is a Customer of at Least One of a Financial Institution and An Entity Associated with the Financial Institution**

Claim 14 of the present application recites “receiving information related to personal identification information associated with a consumer who is a **customer of at least one of a financial institution and an entity associated with the financial institution.**” Gardenswartz fails to teach or suggest a financial institution or an entity associated with a financial institution. Gardenswartz is directed towards tracking purchase histories of consumers at stores. *See* Figure 1, elements 2, 4, 6, and 8; Figure 2(a); Figure 2(b), element 36. Gardenswartz states “purchase history database 8 stores purchase data received from the stores 2, 4, 6.” Gardenswartz column 6, lines 10-11. Gardenswartz further states “the advertisements might be for product offers that are only good at stores, such as stores 2, 4, 6, that provide purchase history information to the purchase history database 8.” Gardenswartz, column 14, lines 26-29. Gardenswartz is directed towards advertisements based on purchase histories at retail stores. Gardenswartz fails to teach or suggest “receiving information related to personal identification information associated with a consumer who is a **customer of at least one of a financial institution and an entity associated with the financial institution,**” as recited in claim 14.

The Office admits that Gardenswartz fails to disclose a financial instrument and credit checking. *See* Office Action, page 6. However, the Office fails to address “receiving information related to personal identification information associated with a consumer who is a **customer of at least one of a financial institution and an entity associated with the financial institution,**” as recited in claim 14. Applicant respectfully submits that an assertion that it is possible to modify Gardenswartz to incorporate financial products and credit checking does not address the above limitation.

Furthermore, Applicant notes that the citations by the Office for this element (i.e., Figure 5, elements 500, 502; column 10, lines 3-9, Figures 6, 7 and corresponding descriptions) fail to teach or suggest “receiving information related to personal identification information associated with a consumer who is a **customer of at least one of a financial institution and an entity associated with the financial institution,**” as recited in claim 14. For at least these reasons, independent claim 14 is patentable over Gardenswartz.

Regarding claim 31, this claim recites subject matter related to claim 14. Thus, the arguments set forth above with respect to claim 14 are equally applicable to claim 31. Accordingly, it is respectfully submitted that claim 31 is allowable over Gardenswartz for analogous reasons as set forth above with respect to claim 14.

Regarding claims 15-30, these claims are dependent upon independent claim 14. Thus, since independent claim 14 should be allowable as discussed above, claims 15-30 should also be allowable at least by virtue of their dependency on independent claim 14.

IV. Rejections Under 35 U.S.C. § 103

Claims 1-13 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,055,573 to Gardenswartz *et al.* (“Gardenswartz”). *See* Office Action, pages 4-9. Applicant hereby respectfully traverses this rejection.

A. Gardenswartz Fails to Teach or Suggest All of the Elements of Claims 1-13

Claim 1 of the present application recites:

wherein the pre-qualification data further relates to a determination of whether a consumer identifier associated with the consumer is contained in a suppression database, wherein the suppression database comprises a plurality of second consumer files, each of the second consumer files linked to a unique consumer identifier, wherein the second consumer files comprise suppression

information relating to a determination that the consumer associated with the second consumer file is no longer qualified to be offered one or more of the pre-qualified financial instruments stored in the first consumer file.

Applicant respectfully submits that Gardenswartz fails to teach or suggest “wherein the pre-qualification data further relates to a determination of whether a consumer identifier associated with the consumer is contained in a suppression database,” as recited by claim 1.

Regarding claim 12, although this claim is of different scope than claim 1, this claim is allowable over Gardenswartz for analogous reasons. For example, claim 12 recites :

a suppression database comprising a plurality of second consumer files, each of the second consumer files linked to the unique consumer identifier of a consumer, wherein the second consumer files comprise suppression information relating to a determination that the consumer associated with the second consumer file is no longer qualified to be offered one or more of the pre-qualified financial instruments stored in the first consumer file.

Gardenswartz fails to teach or suggest a “ suppression database.”

Regarding claims 2-11, and 13, these claims are dependent upon independent claims 1 and 12, respectively. Thus, since independent claims 1 and 12 should be allowable as discussed above, claims 2-11, and 13 should also be allowable at least by virtue of their dependency on independent claims 1 and 13. Moreover, these claims recite additional features which are not taught or even suggested, by the applied references taken either alone or in combination.

As stated in MPEP § 2143.03, to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). That is, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382 (CCPA 1970).

B. Gardenswartz Teaches Away From the Proposed Modification

The Office admits that Gardenswartz “does not explicitly teach pre-qualifying a consumer for a financial instrument by checking his credit rating.” *See* Office Action, page 6. Thus Gardenswartz fails to teach or suggest “a second interface unit in communication with the system configured to communicate at least some consumer information and to receive pre-qualification data from at least one third party,” as recited in claim 1. However, the Office asserts that a person of ordinary skill in the art at the time of the invention would have been motivated to modify Gardenswartz “to include the financial instrument product and credit rating checking to offer consumer with different products.” *See* Office Action mailed July 24, 2008, page 5. Applicant respectfully disagrees.

Gardenswartz teaches away from making the proposed modifications. To modify Gardenswartz as proposed would require Gardenswartz to “communicate at least some consumer information and to receive pre-qualification data from at least one third party,” as recited in claim 1. Gardenswartz states “[i]t is another object of the present invention to provide a novel method, system, and computer program product for providing advertisers with information relating to consumers' observed offline purchase histories **without divulging to the advertisers the proprietary information of another, such as the consumers' customer identifications (CIDs).**” *See* Gardenswartz, column 2, line 66 - column 3, line 4 (emphasis added).

Gardenswartz states in numerous places that it is undesirable to disclose customer identifications to third parties. *See* Gardenswartz, column 2, line 66 - column 3, line 4; and Gardenswartz column 13, lines 40-45. Thus, Gardenswartz teaches away from a proposed modification which would require disclosure of personal identification to third parties. For at least these reasons the Office's proposed modifications are improper.

Regarding claim 12, this claim recites subject matter related to claim 1. Thus, the arguments set forth above with respect to claim 1 are equally applicable to claim 12. Accordingly, it is respectfully submitted that claim 12 is allowable over Gardenswartz for analogous reasons as set forth above with respect to claim 1.

Regarding claims 2-11, and 13, these claims are dependent upon independent claims 1 and 12, respectively. Thus, since independent claims 1 and 12 should be allowable as discussed above, claims 2-11, and 13 should also be allowable at least by virtue of their dependency on independent claims 1 and 12.

Accordingly, Applicant respectfully submits that claims 1-13 should be allowable over Gardenswartz.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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